

REMARKS

Applicants thank Examiner Sudhaker Patel and Sr. Examiner Richard Raymond for extending the courtesy of a personal interview with Keith MacMillan (ICOS patent counsel) on April 26, 2004 . Applicants also appreciate Sr. Examiner Richard Raymond extending the courtesy of a telephonic interview with Keith MacMillan on May 17, 2004 regarding the inclusion of claim 12 into the case.

I. Status of the Claims

Claims 1-19 and 26-43 are pending in the application. Claims 20-25 and 44-60 have been withdrawn from consideration. Claims 8, 11, and 15 have been allowed. In this Amendment, claims 1, 11 and 12 have been amended and claims 2-10, 14, 16, and 19-43 have been canceled. Accordingly, claims 1, 11-13, 15, 17, and 18 remain in the application.

Applicants have agreed to place the claims in condition for allowance by amending claim 1 to incorporate the limitations of claims 4 and 8. Accordingly, claim 1 has been amended to delete "unsubstituted aryl or unsubstituted heteroaryl group" from the definition of Ar, such that Ar is now a substituted aryl or substituted heteroaryl group (claim 8). Claim 1 has also been amended to recite, "R₃ is a "cis-cinnamide" or a "trans-cinnamide," and "at least one of R₁, R₈ and R₉ are hydrogen" (claim 4). As noted above, claims 4 and 8 have been canceled.

Claim 11 has been amended to be dependent from claim 1, instead of canceled claim 8.

Claim 1 has been further amended to include the definition of "heterocyclyl" as set forth in the specification at p. 15, line 18 to p. 17, line 5.

Claim 12 has been amended to remove compounds that do not fall within the genus of currently amended claim 1.

By these amendments, Applicants do not concede that any other claims are unpatentable and reserve the right to pursue such claims in a continuation application.

No new matter has been added by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

II. Rejection under 35 U.S.C. § 112

The Examiner has rejected claims 1-7, 9, 10, 12-14, 16-19 and 26-37 under 35 U.S.C. § 112, second paragraph as being indefinite. (*Advisory Action* at p. 2.)

Applicants respectfully traverse this rejection.

The Examiner continues to reject the claims because the term "heterocyclyl" and its derivatives are allegedly indefinite. (*Id.*)

Applicants respectfully disagree that "heterocyclyl" is indefinite as understood by one of ordinary skill in the art. Nonetheless, to expedite prosecution, claim 1 has been amended to include a definition of "heterocyclyl" as set forth in the specification at p. 15, line 18 to p. 17, line 5. Moreover, Applicants note that the cancellation of claims 2-10, 14, 16, and 19-43 renders this rejection moot as to these claims.

The Examiner contends that the elected species of Example 399 is not accommodated by claim 1 where “the definition of Ar as substituted aryl wherein the substituent is either unsubstituted heterocyclyl or unsubstituted heterocyclylalkyl does not exactly and definitely describe the nature of the ring.” (*Id.*)

Applicants respectfully disagree and submit that Example 399 falls within the genus of amended claim 1. In amended claim 1, Ar can be a substituted aryl having at least one substituent, each substituent independently selected from ... “n. substituted heterocyclyl.” In Example 399, Ar is a phenyl substituted with a piperidine ring, which in turn is substituted at the 3-position by a carboxy group. Because a carboxy-substituted piperidine falls within the definition of “substituted heterocyclyl,” Example 399 is encompassed by amended claim 1. By these amendments and remarks, Applicants believe that the rejection has been overcome and respectfully request withdrawal of this rejection.

III. Objection to claims

The Examiner has objected to claims 38-43 under 37 C.F.R. § 1.75(c). (*Advisory Action* at p. 3.) As Applicants have canceled claims 38-43, this objection is now moot.

The Examiner has objected to claims 12 and 13, alleging that the “more than 450 separate compounds ... in no way constitute a reasonable number of species for the examination purpose.” (*Id.*) Applicants respectfully disagree with the position of the Examiner and submit that claims 12 and 13 do not constitute an unreasonable number of species. Moreover, most of the compounds of claim 12 fall within amended claim 1; those that do not fall within claim 1 have been deleted. Applicants attach a chart

depicting each compound listed in claim 12, and its corresponding example in the specification. Accordingly, Applicants respectfully request withdrawal of this objection with respect to claims 12 and 13.

IV. Provisional Double Patenting Rejection

The Examiner continues to reject claims 1-10, 12-14, 16-19, and 26-43 under the judicially created doctrine of obviousness type double patenting over co-pending U.S. Application Nos. 09/695,040 and 10/356,794. (*Advisory Action* at p. 3.)

Applicants note that Application No. 09/695,040 is now abandoned. Accordingly, this rejection is now moot.

While Applicants respectfully disagree with the position of the Examiner, to expedite prosecution, Applicants have filed a Terminal Disclaimer in reference to application 10/356,794 to render the rejection moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

The Examiner notes that Applicants have not surrendered U.S. Patent No. 6,110,922. (*Id.*) On April 6, 2004, Applicants filed a Form PTO/SB/55 Reissue Patent Application Statement As To Loss Of Original Patent, effectively surrendering the original patent.

V. Cited References

The Examiner asserts that the cited references DE 4030041, WO 98/22423, EP 722928, and WO 98/13347 teach "compounds of Formula I" as recited in claims 1, 37, 47, and 52. (*Advisory Action* at p. 4.) Applicants respectfully traverse.

Applicants have canceled claims 37, 47, and 52. Therefore, the rejection of claims 37, 47 and 52 is now moot.

Because the Examiner has indicated the allowability of claims 8, and because Applicants have amended claim 1 to incorporate the limitations of claim 8, Applicants respectfully submit that the rejection in view of the cited references is now moot.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (617) 452-1621.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 25, 2004

By: Maria T. Bautista
Maria T. Bautista
Reg. No. 52,516